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REMARKS

Applicants and the undersigned thank Examiners Morgan and Thomas for the courtesies extended during the recently held interviews. The remarks below reflect what was discussed in the interviews.

Claims 15, 16, and 21 have been amended to more clearly describe the claimed invention in light of the interviews. New claims 22 and 23 have been added. New independent claim 22 includes features discussed in the interviews and support for claim 22 can be found in at least paragraphs [0149], [0185], the Abstract, and in figures 1, 3 and 4. New independent claim 23 describes a method for an automated appeal process and support for claim 23 can be found in at least paragraph [0149].

Reconsideration and allowance of the pending claims is requested in light of the remarks below.

A. There is no evidence for the Examiner's conclusion that Burchetta teaches a request for reconsideration of a claim adjudicated by an insurer.

Claims 1, 3, 4, 6-8, and 13-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Burchetta. Claims 2, 11, and 12 stand rejected under 35 USC 103(a) as being unpatentable over Burchetta in view of Israel. Claim 5 stands rejected as unpatentable over Burchetta in view of Barber. These rejections are substantially similar to those made in the Action dated August 23, 2005, and are respectfully traversed for the reasons given in the response filed February 1, 2006, which is incorporated herein by reference.

In the outstanding Action, at page 26, the Examiner responded to arguments made in Applicants' response of February 1. Applicants respectfully submit that the Examiner's response does not provide a basis for maintaining the rejections.

In the Action, the Examiner stated, and Applicants do not disagree, that Burchetta teaches a computerized system for automated dispute resolution of claims that may or may not be in litigation. Representative independent claim 1, however, describes that "the appeal

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is a request for reconsideration of a claim adjudicated by an insurer." The Examiner does not maintain that Burchetta teaches processing an appeal that is a "request for reconsideration of a claim adjudicated by an insurer." Rather, the rejection of the claims has been made under 35 U.S.C. §103(a) and the Examiner appears to agree that there is no teaching of this feature in Burchetta or any other reference of record.

While the Examiner recognized the failure of the prior art to teach this claimed feature, the Examiner has impermissibly maintained the rejection. In the Examiner's Response to Arguments on page 26 of the Action, the Examiner stated that "[t]he Examiner considers litigation which is not pending as a claim that has been adjudicated by an insurer..." The Examiner supported the rejection based only on his consideration with a citation to *In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995).

Applicants submit that it is an insufficient basis for a rejection of the claims that "the Examiner considers" the demand for money disclosed by Burchetta to be the claimed request for reconsideration of a claim that has been adjudicated by an insurer. It is insufficient because the Examiner has failed to provide any evidence at all for his "consider[ation]."

In re Graves does not support the Examiner's rejection. Recognizing *In re Graves*, the Board in *Ex parte Donaldson* (Unpublished BPAI opinion in Appeal No. 1998-0595), concluded that the Examiner's reliance on *Graves* was misplaced. In that case, the Board concluded that:

As for the Federal Circuit's decision in *In re Graves*..., which the examiner also cited, it appears that the examiner is relying on the notion that what is otherwise known to one with ordinary skill in the art need to be described in a prior art reference. That, however, does not help the examiner's position here, because the examiner has made no demonstration based on evidence in the record that putting a spindle synchronization command...was known to one of ordinary skill in the art.

(*Ex parte Donaldson*, emphasis added.) See also, *In re Lee*, 61 USPQ2d 1430, 1437 (Fed. Cir. 2002) (quoting *Zurko* to show that the Patent Office must provide documented evidence and cannot rely on general conclusions about what is "basic knowledge and

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"common sense"). The only basis for the Examiner's rejection of the claims as obvious is a review of Applicants' disclosure and the application of impermissible hindsight. The Federal Circuit and the Board have made it clear that the Examiner's unsupported consideration that the automated disputes of Burchetta are claims that have been adjudicated by an insurer cannot form the sole basis for a rejection of the claims.

Applicants submit that the Examiner's basis for the rejection in this case is no better supported than the basis found to be insufficient in *Ex parte Donaldson* which, while not precedential, is indicative of how the Board addresses this type of issue.

B. Burchetta does not teach an appeal that relates to a request for reconsideration of a determination of entitlement to a benefits or services.

Claims 15-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Burchetta. These rejections are respectfully traversed. Independent claim 15 recites that "the appeal relates to a request for reconsideration of a determination of entitlement to benefits or services." On page 22 of the Action, the Examiner stated that this feature is taught by the description in Burchetta of a central processing unit that receives information corresponding to three settlement offers and that a plaintiff or claimant can enter three demands over a period of time. (See Burchetta at col. 2, lines 3-6.) While Applicants recognize that Burchetta teaches receipt of a series of demands and offers, Applicants respectfully submit that Burchetta does not teach or suggest any form of "appeal" that "relates to a request for reconsideration of a determination of entitlement to benefits or services."

Burchetta is not analogous and is completely unrelated to the claimed invention. Burchetta describes only that a "demand" is "the amount of money required by the person having a claim...against another person...such as a defendant or his insurer, for which the person with the claim would be willing to settle." (Col. 3, lines 54-57.) Burchetta describes that an "offer" is "the amount of money the defendant or the insurance company will settle the claim." (Col. 3, lines 61-63.) Thus, the offer and demand of Burchetta are nothing more than

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dollar amounts. Burchetta describes a process whereby two parties can agree, through a negotiation process, on a dollar amount to be paid on a claim. Burchetta does not describe anything that relates to a "determination of entitlement."

As discussed in the interview, the systems and methods described by the claims do not assume that an individual has a claim for any amount of money. Rather, the pending claims relate to sending information to an appeal unit for reconsideration of a determination of an entitlement to benefits or services. The claimed invention does not require a demand for money or the transfer of any amount of money from one party to another, per se. Furthermore, the present invention is not directed to and does not claim a negotiation process by which the amount of money demanded may be decreased in response to a rejection.

Burchetta only describes a negotiation process whereby two parties can negotiate a specific dollar amount for settlement of a claim. There is no suggestion anywhere in Burchetta that the described negotiation process in any way involves a claim that has been adjudicated by an insurer.

C. Newswire does not teach selecting a reason for an appeal of a denial.

In connection with claim 15, the Examiner recognized that Burchetta fails to teach associating appeal data with one or more bases for an appeal. The Examiner stated at page 23 of the Action that Newswire teaches a MediClaim module that performs optical character recognition (OCR) and validation on medical claim information. The Examiner then concluded that this OCR with validation teaches "associating the appeal data with one or more bases for an appeal."

Claim 15 has been amended and Applicants submit that Newswire also fails to teach "automatically selecting a reason for an appeal of the denial, the selection being based upon the appeal data." Newswire teaches software for automated medical claims processing. The reference describes that the software begins by optically scanning handwritten or machine print medical claim forms. After recognition, the data is then verified. Newswire teaches, at

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paragraph 13, that the validation step includes checking for mis-marked or illegible entries, correcting errors, and checking all fields for formatting and content. After validation, the software can export data in certain standard formats.

Applicants submit that Newswire fails to teach selecting a reason for an appeal based upon appeal data, automatically or otherwise. Newswire does not teach any system capable of selecting any reason of any kind for any purpose. Newswire teaches a very simple system that performs OCR on medical claim data and then checks that data to ensure that it complies with certain conventions. There is no suggestion anywhere that any appeal has taken place or will take place. There is also no suggestion anywhere of a basis for such an appeal. Newswire only teaches data acquisition.

In the Action at page 23, the Examiner stated that the customized validations on ICD-9 and CPT data teach "one or more bases for an appeal." Applicants submit that one of ordinary skill in the art would recognize that ICD-9 and CPT data are diagnostic and treatment coding schemes. These schemes provide standardized codes for medical procedures and have the general purpose of facilitating billing and data collection for medical procedures and conditions. Even if the codes referenced in Newswire could somehow be used in connection with an insurance appeal, there is no suggestion anywhere that these standardized codes are useful for selecting a reason for an insurance appeal.

Claim 15 is therefore allowable. Independent claim 21 is also allowable for the reasons given above with regard to independent claim 15.

D. Conclusion

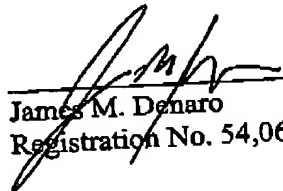
Applicants respectfully submit that all independent claims and the claims dependent thereon are patentable for at least the reasons above. Early action allowing claims 1-23 is solicited. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

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In the event that the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees in connection with the filing of this document to Deposit Account No. 50-2283 referencing docket no. 621848001US.

Respectfully submitted,
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Date: 8-21-06


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